

REMARKS

Status of the Claims

Claim 10 has been amended to replace the recitation of “at least one compound or additive selected from phosphorus additives and epoxy compounds” with “an epoxy compound.” Claim 13 also has been amended to recite “an epoxy compound.” Support for the amendments to the claims can be found in the as-filed specification, e.g., in paragraph [0190].

Claim 15 has been cancelled without prejudice or disclaimer.

New claim 19 has been added, and support for the amendment can be found in the as-filed specification, e.g., in paragraph [0175].

New claims 20-22 have been added to recite a refrigerating machine fluid composition incorporating subject matter of claims 10, 13, and 16, as previously presented before the foregoing amendments. Support for the amendments to the claims can be found in the as-filed specification, e.g., in paragraphs [0216]-[0219].

No new matter has been introduced.

Claims 10-14 and 16-22 are pending.

Response to 35 U.S.C. § 102(b) Rejection

Applicant respectfully traverses the rejection of claims 10-18 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 7,595,286 to Yokota et al. (“Yokota”) for at least the following reasons.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131.

Amended independent claims 10 and 13 each recite, among other things, an epoxy compound, which is not disclosed expressly or inherently in Yokota. Yokota instead discloses a lubricating oil composition comprising sulfur and/or phosphorous compounds as additives. See *e.g.*, Yokota, col. 7, lines 25-26, and col. 12, lines 43-47.

Since anticipation under § 102 requires that every claim element be disclosed, expressly or inherently in a single reference, amended claims 10 and 13 are not anticipated by Yokota. Claims 11 and 12, and new claim 19, depend from claim 10 and incorporate all of the features of amended claim 10. Accordingly, claims 11, 12, and 19 also are not anticipated by Yokota. Claim 14 depends from claim 13 and incorporates all of the features of amended claim 13. Accordingly, claim 14 also is not anticipated by Yokota.

Independent claim 16 recites, among other things, a full ester of a diol or a polyol having 3-20 hydroxyl groups with a fatty acid having 6-20 carbon atoms as a base oil, and at least one oxygen-containing compound selected from the group consisting of (A4) Dihydric alcohol having 2-20 carbon atoms apart from polyalkylene glycol, and (A7) Hydrocarbyl ether of (A4).

Yokota does not disclose, expressly or inherently, at least the above-quoted features recited in claim 16. Regarding claim 16, the Office Action alleged that Yokota discloses diethylene glycol monoalkylether. Office Action at 4. But, the alleged

diethylene glycol monoalkylether of Yokota is not a (A4) Dihydric alcohol having 2-20 carbon atoms apart from polyalkylene glycol, or a (A7) Hydrocarbonyl ether of (A4).

Since Yokota fails to disclose each and every element of claim 16, claim 16 and its dependent claims 17 and 18 are not anticipated by Yokota under § 102(b).

The rejection of claim 15 is moot since the claim is cancelled.

New Claims 20-22

New claims 20-22 each recite, among other things, “[a] refrigerating machine fluid composition, comprising . . . at least one refrigerant selected from HFC refrigerants, natural refrigerants and mixtures thereof.” Yokota does not disclose expressly or inherently the above-quoted features. Specifically, nothing in Yokota discloses, or even suggests, any of the specific refrigerants recited in claims 20-22.

Since Yokota fails to disclose or suggest every element of claims 20-22, claims 20-22 are allowable over Yokota.

Double Patenting Rejection

The Office Action maintained the provisional rejection of the claims on the grounds of nonstatutory obviousness-type double patenting over claims 1-9 of copending Application No. 10/565,739. Office Action at 4-5. Applicant respectfully traverses the double patenting rejection of the pending claims. Nevertheless, in order to move this case forward, Applicant submits herewith a Terminal Disclaimer, rendering the rejection moot. The filing of this Terminal Disclaimer in no way manifests an admission by Applicant as to the propriety of the double patenting rejection. See M.P.E.P. § 804.02 citing *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). Applicant reserves the right

to argue the distinctness or lack of distinctness of the pending claims and the claims of the '739 application at a later date, if necessary.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of the claims, withdrawal of the rejections, and a timely notice of allowance.

Please contact the undersigned should there be any questions or comments.

If there is any fee due in connection with the filing of this response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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Attachment: Terminal Disclaimer